



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,247	04/05/2004	Wray Russ	033131-019	7472

21839 7590 08/08/2005

BUCHANAN INGERSOLL PC
(INCLUDING BURNS, DOANE, SWECKER & MATHIS)
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

TADESSE, YEWEBDAR T

ART UNIT	PAPER NUMBER
----------	--------------

1734

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/820,247

Applicant(s)

RUSS, WRAY

Examiner

Yewebdar T. Tadesse

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/5/04&8/13/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of group I (claims 1-12) in the reply filed on 06/06/2005 is acknowledged.

2. Claims 13-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 06/06/2005.

It's noted that applicant has filed a preliminary Amendment on March 21, 2005 adding new claims (17-30) drawn to an apparatus. In examining the instant application, the examiner has combined these claims with the apparatus claims of group I. Per applicant's election, claims 1-12 and 17-30 have been examined as follow:

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-3 and 5-9 and 11-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7 of U.S. Patent No. 6,887,313 in view of Cummins et al (US 6,760,052).

As to claims 1-3 and 6-9 and 12, US'313 discloses every aspects claimed invention except that the system encompassing at least one duplication system configured to receive the disc (medium) from the dispenser and write data onto the disk and a conveyor belt guide configured to guide the disc onto a conveyor belt. However, an inline writing and marking system having a duplication system is well known in the art. For instance – Cummins et al discloses (see Fig 1) a writing and marking system (disc printer and recorder 10) comprising at least one duplication system (burner or recorder 40) configured to receive the disk (25A) from the dispenser and write data onto the disk, wherein the tray (22) has an extended position to receive the disk from the disc dispenser and a retracted position, wherein data is written (see column 5, lines 20-22). Furthermore, Cummins et al discloses a guide member (gripper 24) configured to guide the disk from one position to another position. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include at least one duplication system as claimed in US'313 to minimize the amount of apparatus that is used, by utilizing common disc transporter to sequentially process the duplication and printing or marking process (see column 1, lines 35-40). It would also have been obvious to one of ordinary skill in the art at the time the invention was made to include a (conveyor) guide member in US'313 to transfer the processed disk from processing station to the common disk transporters or conveyors. The conveyor belt of US'313, as

Art Unit: 1734

modified is capable of receiving the disc transferred by a gripper from the duplication device.

As to claims 5 and 11, claim 7 of '313 teaches the claimed feature.

5. Claims 4 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,887,313 in view of Cummins et al (US 6,760,052) as applied to claim 1 above and further in view of Miller et al (US 6,222,800). US' 313 lacks claiming a dispenser configured to dispense a lower-most disk from the stack of disks. Miller et al discloses (see column 5, lines 31-51) a dispenser (carrier 32) configured to dispense a lower most disk 46. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a dispenser configured to dispense a lower-most disk from the stack of disks in US'313 as desired.

6. Claims 17-18, 20, 22-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,887,313 in view of Uchida et al (US 6,499,841). US'313 discloses every aspects of the claimed invention except that a pad located underneath the marking device and at least one duplication system configured to receive the disc (medium) from the dispenser and write data onto the disk. Uchida et al discloses (see Fig 3) a pad (245) located underneath the marking device (head 221). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a pad

Art Unit: 1734

underneath the marking system to collect the ink material coming out of the marking device. As to the duplication system, Cummins et al discloses (see Fig 1) writing and marking system (disc printer and recorder 10) comprising at least one duplication system (burner or recorder 40) configured to receive the disk (25A) from the dispenser and write data onto the disk. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include at least one duplication system as claimed in US'313 to minimize the amount of apparatus that is used, by utilizing common disc transporter to sequentially process the duplication and printing or marking process (see column 1, lines 35-40).

7. Claim 19 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,887,313 in view of Uchida et al (US 6,499,841) as applied to claim 17 and further in view of Armelin (US 4,810,153). US'313 lacks teaching a plurality of rollers attached to a motor assembly controlling the movement of the conveyor belt assembly. Armelin discloses (see Fig 1A) a plurality of rollers (27, 28, 29) attached to a motor assembly (25) controlling the movement of a conveyor belt assembly (13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a plurality of rollers attached to a motor assembly to drive the conveyor belt.

8. Claim 21 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,887,313 in

Art Unit: 1734

view of Uchida et al (US 6,499,841) as applied to claim 17 above and further in view of Rezanka (US 5,757,407). US'313 lacks claiming a marking system not including a pad. Rezanka marking system does not include a pad. It would have been obvious to one of ordinary skill in the art at the time the invention was made to not include a pad in the system of US'313 as desired.

9. Claims 24-27 and 29-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,887,313 in view of Armelin (US 4,810,153). As to claims 24-25, 27 and 29-30 US'313 discloses every aspects of the claimed invention except a system comprising a conveyor belt assembly having a chassis assembly with a support frame having a first section and a second section and at least one duplication system configured to receive the disc (medium) from the dispenser and write data onto the disk. Armelin discloses (see columns 4-5, lines 64-68 and 1-3 respectively and Fig 4) a chassis (34) comprising a support frame having a first section and a second section. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a chassis assembly comprising a support frame having a first section and a second section in '313 to correctly displace the substrate (disk) in the desired direction. As to the duplication system, Cummins et al discloses (see Fig 1) writing and marking system (disc printer and recorder 10) comprising at least one duplication system (burner or recorder 40) configured to receive the disk (25A) from the dispenser and write data onto the disk. It would have been obvious to one of ordinary skill in the art at the time the

Art Unit: 1734

invention was made to include at least one duplication system as claimed in US'313 to minimize the amount of apparatus that is used, by utilizing common disc transporter to sequentially process the duplication and printing or marking process (see column 1, lines 35-40).

With respect to claim 26, US'313 lacks teaching a plurality of rollers attached to a motor assembly controlling the movement of the conveyor belt assembly. Armelin discloses (see Fig 1A) a plurality of rollers (27, 28, 29) attached to a motor assembly (25) controlling the movement of a conveyor belt assembly (13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a plurality of rollers attached to a motor assembly to drive the conveyor belt.

10. Claim 28 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,887,313 in view of Armelin as applied to claim 24 above and further in view of Rezanka (US 5,757,407). US'313 lacks claiming a marking system not including a pad. Rezanka marking system does not include a pad. It would have been obvious to one of ordinary skill in the art at the time the invention was made to not include a pad in the system of US'313 as desired.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yewebdar T. Tadesse whose telephone number is (571)

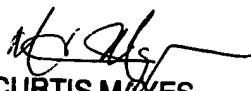
Art Unit: 1734

272-1238. The examiner can normally be reached on Monday-Friday 8:00 AM-4: 30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


YTT


CURTIS MAYES
PRIMARY EXAMINER